REMARKS

The Examiner has rejected all claims in view of Rivette 6,014,663 (Rivette '663) either under 35 U.S.C. § 102 or § 103. By this amendment, claims 1 and 8 have been amended. Reconsideration is respectfully requested. New claims 11-32 are also presented for consideration at this time.

Claims 1-7:

Rivette '663 relates to a system and method for comparing the respective text portions of a patent specification and patent claims—to assist the drafter in ensuring that terms are used consistently. Rivette '663 separately analyzes: (a) the specification portion of the patent application and (b) the claims portion of the patent application, to generate specification index and a claims index. These two indices are then merged and used to identify terms in the claims portion that are not present in the specification portion. Each index comprises a list of words and an associated number showing the number of times each word occurred in the corresponding portion of text.

Notably, the Rivette '663 index lists do not serve a claim breadth metrics. Rather, they are used to identify terms in the claims portion that are not present in the specification portion. To the extent the Examiner is construing the "number of hits" recorded in Rivette's index lists as "claim breadth metric" values, such construction is inappropriate.

In applicants' invention, the claim text of an individual claim is analyzed and a claim breadth metric is determined for that individual claim. In this way, applicants' invention is able to sort claims in order of ascending or descending claim breadth order.

In contrast, Rivette does not generate and associate such a claim breadth metric with individual claims. Rather, Rivette treats the entire claims portion of the patent as a single entity—no individual claim-by-claim analysis is done. Thus Rivette does not generate claim breadth metrics as the applicants' system and method does.

In order to more fully distinguish applicants' claim breadth metric from Rivette's index lists containing "number of hits" for individual words, claim 1 has been amended to recite that applicants' claim breadth metric as <u>corresponding individually to said at least one claim</u>. While applicants do not concede that Rivette's index system constitutes a claim breadth metric, the amended language serves to further distinguish applicants' invention from Rivette '663. Accordingly, it is respectfully submitted that claim 1 is allowable over the cited reference.

Claims 2-7 are dependent upon claim 1 and are therefore also allowable over the cited reference.

<u>Claims 8-10</u>:

The Examiner has also rejected claims 8-10 in view of Rivette '663. Reconsideration is respectfully requested.

Rivette '663 creates a "Category" column in the index list, into which a "C" is recorded if the corresponding word was found in the claims portion, and into which an "S" is recorded if the corresponding word was found in the specification portion. These categories are used in the Rivette system to assist the user when he or she revises the application to achieve terminology consistency.

In contrast with Rivette '663, the applicants' invention analyzes the patent information to generate category metrics that correspond to user-prescribed categories.

Non-limiting examples of such categories include, technological categories, product categories, or other business categories. These user-prescribed categories allow the user to quickly understand the scope of a patent portfolio, buy associating patents with category terminology that is familiar to the user or to the audience that will be reviewing the results of the portfolio analysis.

In order to more fully distinguish the applicants' invention from Rivette '663 in this regard, claim 8 has been amended to describe applicants' category metric as corresponding to user-prescribed categories. It is submitted that claim 8 now fully distinguishes the applicants' invention from Rivette '663. Claims 9-10 are dependent upon claim 8 and are also allowable for the same reasons.

Other formal matters:

The Examiner has requested the applicant to amend the title of the application. This has been done. In addition, revised drawings have been prepared and submitted herewith for the Examiner's approval. In addition, applicants have revised the "Cross-reference to related applications" to more fully recite the particulars and to incorporate by reference.

CONCLUSION

In view of the foregoing, it is respectfully submitted that this application is now in a condition for allowance. Allowance is therefore courteously solicited at this time.

Should the Examiner wish to discuss any matters relating to this Amendment, or relating to the present application, the Examiner is respectfully encouraged to call the undersigned at 248-641-1600.

Respectfully submitted,

Dated: _Aug 30, 2002_

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ATTACHMENT FOR SPECIFICATION AMENDMENTS

The following is a marked up version of each replacement paragraph and/or section of the specification in which underlines indicates insertions and brackets indicate deletions.

Please amend the title of this application to read:

COMPUTER-IMPLEMENTED PATENT PORTFOLIO ANALYSIS METHOD AND APPARATUS EMPLOYING CLAIM BREADTH AND CATEGORY METRICS

Please amend the Cross-Reference to Related Applications to read:

This application [ ] claims priority to U.S. provisional application Serial No. 60/119,210, filed February 5, 1999. By this reference, the full disclosure, including the drawings, of U.S. provisional application Serial No. 60/119,210 is incorporated herein.

The following is a marked up version of each amended claim in which underlines indicates insertions and brackets indicate deletions.

1.   (amended)   A computer-implemented patent portfolio analysis method comprising:

retrieving a corpus of patent information from a database, said information including the claim text of at least one claim;

analyzing the claim text of said at least one claim to generate a claim breadth metric <u>corresponding individually to said at least one claim</u>;

associating said claim breadth metric with said claim text and storing said associated metric in a computer-readable dataset.

8.   (amended)   A computer-implemented patent portfolio analysis method comprising:

retrieving a corpus of patent information from a database;

analyzing said patent information to generate a category metric <u>corresponding to user-prescribed categories</u>; and

associating said category metric with said patent information and storing said associated metric in a computer-readable dataset.

11.   (new) <u>A computer-implemented patent portfolio analysis method comprising:</u>

retrieving text of claims from a computer-implemented data store, wherein the text of claims are from a plurality of patent documents;

analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim,

wherein the claim breadth metrics are used to analyze the claims.

12.   (new) The method of claim 11 wherein said step of analyzing the claims' text includes counting the number of words in each of the claims and generating a numeric claim breadth metric for each claim therefrom.

13.   (new) The method of claim 11 wherein said step of analyzing the claims' text includes identifying within a claim's text a preamble portion and a body portion, counting the number of words in said preamble and body portions and applying separate weights to said counts to generate said claim breadth metric for a claim.

14.   (new) The method of claim 11 wherein said step of analyzing the claims' text includes parsing said text to identify parts of speech, using said identified parts of speech to identify clauses within a claim, comparing said clauses with the text of other claims to generate scores indicative of which clauses within said claim text have a lower probability of being found in other claims within said patent documents.

15.   (new) The method of claim 11 further comprising displaying said patent documents in a sorted order based on said claim breadth metrics.

16.   (new) The method of claim 11 wherein the sorted patent documents are used in a patent infringement study.

17.   (new) The method of claim 11 wherein the sorted patent documents are used to determine patent documents whose maintenance fees are not to be paid.

18.   (new) The method of claim 11 wherein said step of analyzing the claims' text includes linguistically processing said text to identify at least one clause within said claim text that has a lower probability than other of said clauses within said claim text of being found in other claims within said patent documents.

19.   (new) The method of claim 18 further comprising displaying said claims' text such that said one clause is visually presented differently than the other of said clauses.

20.   (new) The method of claim 11 further comprising:

generating descriptive statistics based upon the generated claim breadth metrics, wherein the generated descriptive statistics are indicative of quality of claims analyzed.

21.   (new) The method of 20 wherein generated descriptive statistics are generated for groupings of claims.

22. (new) The method of claim 21 wherein the claim groupings are formed based upon patent ownership, wherein the generated descriptive statistics are statistics selected from the group consisting of average, average of the averages, standard deviation, maximum, minimum, and combinations thereof.

23. (new) A computer-implemented patent portfolio analysis method comprising:

retrieving patent information from a database, wherein the patent information is from a plurality of patent documents;

analyzing said patent information to generate category metrics; and

associating said category metrics with said patent documents and storing said associated metrics in a computer-readable dataset.

24. (new) The method of claim 23 wherein said patent information includes patent classification information and wherein said analyzing step is performed by defining a plurality of categories and mapping classification information onto said categories.

25. (new) The method of claim 23 wherein said patent information includes claim text information to be analyzed and wherein said analyzing step includes:

defining an eigenspace representing a training population of training claims each training claim having associated training text;

representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace; and

projecting the claim text information to be analyzed into said eigenspace and associating with said projected claim text the predefined category of the training claim to which it is closest within the eigenspace.

26. (new) The method of claim 23 wherein said patent information includes using both patent classification information and linguistic analysis results to determine said category metrics to be associated with the patent documents.

27. (new) The method of claim 26 wherein the category metrics are indicative of technical areas of the patent documents.

28. (new) The method of claim 23 further comprising:

retrieving text of claims from the database, wherein the text of claims are from the plurality of patent documents;

analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim,

wherein the claim breadth metrics are used to analyze the claims.

29. (new) The method of claim 23 wherein values of the category metrics are predetermined.

30.   (new) The method of claim 23 wherein values of the category metrics are dynamically determined.

31.   (new) A computer-implemented patent portfolio analysis apparatus comprising:

a database of patent documents containing text of claims;

a claim breadth analysis module that analyzes the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are provided over an internet network for use in analyzing scope of the claims;

a cluster generator that analyzes patent information to generate category metrics for the patent documents, wherein clusters of patent documents are determined based upon the generated category metrics, wherein the clusters of patent documents are provided over an internet network for use in analyzing the patent documents.

32.   (new) A computer-implemented patent portfolio analysis method comprising:

retrieving a corpus of patent information from a database, said information including the claim text of a plurality of claims;

analyzing the claim text of said plurality of claims to generate and associate an individual claim breadth metric with each of said plurality of claims.